

**PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

Docket Number: 054054/314144

(filed with the Notice of Appeal)

Application Number: 10/597,195

Filed: August 7, 2008

First Named Inventor: Martin Fogg

Art Unit: 2612

Examiner: Mirza F. Alam

Appellant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Respectfully submitted,



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Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 1-4, 6, 7, 9, 11-13 and 15-24 are pending and currently stand rejected. Appellant respectfully requests reconsideration and reversal of the outstanding rejections for the reasons noted below.

Claims 1, 4, 6, 7, 11-13 and 15-24, including independent Claims 1, 11 and 19, were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0012496 (“De Souza”) in view of U.S. Patent Application Publication No. 2003/0173408 (“Mosher”). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over De Souza in view of Mosher and in further view of U.S. Patent No. 5,874,724 (“Cato”). Claims 3 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over De Souza in view of Mosher and in further view of Cato and U.S. Patent Application Publication No. 2004/0233040 (“Lane”).

Appellant respectfully requests that the rejections be reversed, because (1) the Examiner’s *prima facie* case of obviousness is rebutted, and (2) the cited documents, taken alone or in any proper combination, fail to show or otherwise suggest each recitation of Appellant’s claims, namely the recitation of a RFID tag configured to communicate with an RFID tag reader regardless of whether there is light present and the RFID tag’s communications range is larger when a light sensitive component of the RFID tag detects light as compared to when the light sensitive component detects an absence of light.

De Souza is directed to a RFID tag that is “responsive to electromagnetic radiation of a predetermined frequency and for controlling cooperation between the RFID circuitry and the antenna when electromagnetic radiation of the predetermined frequency is detected.” De Souza, abstract. In particular, De Souza either enables or disables “cooperation between the RFID circuitry and the antenna” based on whether light of the predetermined frequency is detected. *Id.* In other words, De Souza’s RFID tag either broadcasts information or does not depending on the presence of light.

As such, De Souza fails to disclose or otherwise suggest communicating information regardless of whether the light sensitive component detects light. The Examiner acknowledges that De Souza fails to disclose or otherwise suggest a RFID tag configured to communicate with an RFID tag reader within a communications range that is larger when a light sensitive

component detects light as compared to when the light sensitive component detects an absence of light. *See* page 4 of the Final Office Action.

Rather than enable different-sized communication ranges based on the presence or absence of light, De Souza takes an all or nothing approach to provide security and “to be able to differentiate signals received from a relatively large number of RFID tags which are located within the operating range of the RFID reader.” De Souza, para. [0004]. As such, De Souza is a binary system that either enables or disables the RFID tag from being read based on whether or not light is detected for the purpose of achieving very specific goals, and therefore teaches away from: a RFID tag configured to communicate with an RFID tag reader within a communications range that is larger when a light sensitive component detects light as compared to when the light sensitive component detects an absence of light, as recited by Appellant’s independent Claims 1, 11 and 19.

Because De Souza teaches away from Appellant’s independent Claims 1, 11 and 19, there cannot be motivation to combine De Souza with another document, such as Mosher, to make Appellant’s independent claims obvious.¹ Yet, the Examiner still uses the motivation to combine rationale to reject Appellant’s claims. *See, e.g.*, the Final Office Action, page 6.

Notwithstanding the rebuttal of the Examiner’s *prima facie* case of obviousness, Appellant also notes that Mosher (and the other documents of record) fails to show or otherwise suggest a RFID tag configured to communicate with an RFID tag reader within a communications range that is larger when a light sensitive component of the RFID tag detects light as compared to when the light sensitive component detects an absence of light, and wherein the RFID tag is configured to communicate information regardless of whether the light sensitive component detects light, as recited by Appellant’s independent Claims 1, 11 and 19.

Mosher is cited to fill this void of De Souza. More specifically, Mosher is cited as showing an identification appliance (“such as a wristband, bracelet, patch, headband, neckband,

¹ “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). In *KSR*, the U.S. Supreme Court recognized that “when prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR Int’l Co. v. Teleflex Inc. et al.*, 550 U.S. 398, 416 (2007) (citing *United States v. Adams*, 383 U.S. 39, 50-51 (1966)). As such, “[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).” MPEP § 2145.X.D. See also MPEP §§ 2141.02 and 2141.03.

ankleband, legband, card, sticker, or other wearable appliance, may have a biometric sensor, chemical sensor, optical sensor, heat sensor, pressure sensor, humidity sensor, electromagnetic sensor, acoustic sensor, various opto-electronics and/or various security features such as tamper-evident and tamper-resistant features,” Mosher, abstract), which can “provide its location to another device, for example, over a small area (e.g., a room or a building) or a large area (e.g., countrywide or worldwide), the location may be derived externally to the identification band, such as by a matrix of RF receivers responding to the strength or timing of reception signals received from the identification band, paragraph 0082 …” (Final Office Action, page 5, emphasis in original). Mosher is also cited as allegedly showing an identification appliance that can use light to determine when to take a fingerprint scan and/or to communicate optically with an external or internal device. *See* Final Office Action, page 5.

Appellant respectfully submits that determining when to scan a finger and/or communicating optically (e.g., over fiber optic cables) is different than and does not show or otherwise suggest a RFID tag configured to communicate with an RFID tag reader within a communications range that is larger when a light sensitive component detects light as compared to when the light sensitive component detects an absence of light, as recited by Appellant’s independent Claims 1, 11 and 19.

Further, although the Examiner’s rationale for combining Mosher with De Souza has been rebutted, the De Souza-Mosher combination (if possible) would produce a Mosher identification appliance that provides its location or otherwise broadcasts information based on De Souza’s binary output (i.e., ON or OFF) signal generated in response to whether or not De Souza’s sensor detects light of a predetermined frequency. The De Souza-Mosher combination (if possible) would fail to show or otherwise suggest a RFID tag configured to communicate with an RFID tag reader within a communications range that is larger when a light sensitive component detects light as compared to when the light sensitive component detects an absence of light, as recited by Appellant’s independent Claims 1, 11 and 19.

Likewise, the other documents taken alone or in any proper combination with De Souza and/or Mosher also fail to show or otherwise suggest a RFID tag that has two different read ranges, namely a large read range and a small read range, dependent on the presence or absence of light, as recited by Appellant’s independent Claims 1, 11 and 19.

Therefore, Appellant respectfully submits that independent Claims 1, 11 and 19 are allowable over the cited documents and requests that the rejections of Claims 1, 11 and 19 be reversed. Likewise, Claims 2-4, 6, 7, 9, 12, 13, 15-18 and 20-24, which depend on one of Claims 1, 11 or 19, are also allowable over the cited documents and should have their rejections reversed for at least the same reasons.